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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Trafficmaster plc**

Serial No. 76/051,058

Ralph D. Gelling of **Perman & Green, LLP** for **Trafficmaster plc**.

Carolyn Pendelton Cataldo, Trademark Examining Attorney, Law
Office 103 (**Michael Hamilton**, Managing Attorney).

Before **Quinn, Hohein** and **Rogers**, Administrative Trademark Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

Trafficmaster plc has filed an application to register
the mark "TRAFFICMASTER" for the following goods and services:¹

"electrical and electronic apparatus and
instruments for provision of road traffic
information, for provision of information as
to road traffic congestion and speed and
about individual road vehicles, for road
traffic monitoring, and for monitoring of
road traffic congestion and speed and of
individual road vehicles; electrical and
electronic apparatus and instruments
locatable in vehicle interiors for providing
visual and oral information relating to road
traffic conditions; electronic equipment in
the nature of numeric, graphic and textual
data processors, wireless and fixed
electronic transmitters and receivers, and
central electronic graphical display systems
for monitoring and communicating with

¹ Ser. No. 76/052,058, filed on May 18, 2000, which is based on a bona fide intent to use such mark in commerce.

individual road vehicles; control centers for performing numeric, graphic and textual data processing, wireless and fixed electronic transmission and reception and central electronic graphical display for monitoring and communicating with individual road vehicles" in International Class 9; and

"provision of road traffic information; provision of information as to road traffic congestion and speed and about individual road vehicles; road traffic monitoring; monitoring of road traffic congestion and speed and of individual road vehicles, and consultation with regard to the provision of such information and the performing of such monitoring and the related equipment used in connection therewith" in International Class 39.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods and services, so resembles the mark "TRAFFICMASTER," which is registered for "portable non-tippable display apparatus for use in displaying warning messages in emergency-type situations in the nature of non-electric signs and metal sign stands,"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed,³ but an oral hearing was not requested. We reverse the refusal to register.

² Reg. No. 1,313,111, issued on January 8, 1985, which sets forth a date of first use anywhere of July 27, 1982 and a date of first use in commerce of August 18, 1982; combined affidavit §§8 and 15.

³ Although the final refusal discusses the issue of likelihood of confusion only as to the respective goods and makes no mention of applicant's services, it is clear from applicant's briefs and the Examining Attorney's brief that the refusal under Section 2(d) is regarded by both applicant and the Examining Attorney as including applicant's services as well as its goods and those of the registrant.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and services and the similarity of the marks.⁴ Here, inasmuch as the respective marks are identical in all respects, including the same highly suggestive overall commercial impression of providing mastery or control over traffic situations or conditions,⁵ it is plain that the contemporaneous use thereof in connection with the same or closely related goods and/or services would be likely to cause confusion as to their source or sponsorship. The principal focus of our inquiry herein is accordingly on the similarities and dissimilarities in the respective goods and services, including similarities and dissimilarities in established, likely to continue channels of trade and the conditions under which and buyers to whom sales are made.

The Examining Attorney maintains that confusion is likely because it "is clear that the applicant's [goods and services] and the registrant's goods serve a similar function,

⁴ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks."

⁵ Applicant, we observe, has not raised any argument to the contrary.

and are likely purchased by the same consumers." In particular, the Examining Attorney appears essentially to contend with respect to applicant's goods that its "electrical and electronic apparatus and instruments for provision of road traffic information, for provision of information as to road traffic congestion and speed and about individual road vehicles, for road traffic monitoring, and for monitoring of road traffic congestion and speed and of individual road vehicles" and its "central electronic graphical display systems for monitoring and communicating with individual road vehicles" are so broadly identified as to encompass items in the nature of electric signs and displays for providing emergency information. Such items, she argues, are so closely related in a commercial sense to registrant's goods, which she regards as including portable non-electric signs for use in displaying warning messages in emergency-type situations, that the contemporaneous use of the mark "TRAFFICMASTER" by applicant and registrant in connection with their respective goods would be likely to cause confusion as to the source or sponsorship thereof.

Specifically, the Examining Attorney asserts in this regard that (*italics in original*):

[N]othing in the registrant's identification of goods indicates that the signs are *not* for use for traffic emergency situations. Therefore, it can be assumed that the registrant's emergency signs, like the applicant's electric signs and displays, are also used to notify drivers of traffic congestion, conditions and/or emergency situations. According to the information provided by the applicant, the goods [of applicant] consist of infrared monitoring units that are bolted to the sides of

bridges, which emit information regarding traffic congestion at their locations to a control center which then transmits the information to respective vehicles. It is clear that the applicant's product is utilized by both members of the general public and by state officials, such as police. It is also unlikely that the applicant's products could be bolted to public roadways, such as bridges, without the permission and cooperation of county or state officials. In fact, ... it [is] likely that state or county officials would not only be consulted prior to affixing the applicant's products to public roadways, but would also subscribe to the applicant's traffic information service. Therefore, the relevant consumers would be state or county officials who are concerned with tracking traffic congestion and traffic emergencies, and these consumers would likely be confused as to the source of the parties' goods.

The evidence of record demonstrates that companies manufacture both manual and electric signs under the same mark. Therefore it is possible that companies, such as the applicant, which sell traffic condition monitoring systems would also sell manual signs for traffic emergencies under the same mark. Even if applicant's goods are expensive, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. See *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). There is no reason to believe that state or county officials who are purchasing traffic condition monitoring systems would not be confused as to the source of road signs for use in emergency traffic situations, particularly given the fact that the parties' marks are identical.

As to the applicant's services, ... it is clear from the evidence of record that companies provide consulting, manufacturing and installation of signs and message centers in connection with the sale of electronic and non-electronic signs.

With respect to the "evidence of record" referred to above, the Examining Attorney relies upon copies of various use-based third-party registrations which, we observe, show that in only three instances is a mark respectively registered for, on the one hand, "signs for traffic signals and luminous signs," "illuminated signs" or "luminous roadway signs" and, on the other hand, "non-luminous, non-mechanical plastic signs not of metal," "metal signs" or "non-luminous road signs made of metal."⁶ We also note, in view of registrant's "metal sign stands" and applicant's various goods, that there appear to be just two third-party registrations for marks which respectively cover such goods as "sign holders" or "sign stands," on the one hand, and "signs for traffic signals and luminous signs" or "illuminated signs," on the other hand.⁷ Additionally, we observe that, of the nine use-based third-party registrations made of record, there are only two registrations, both of which are owned by the same entity, in which a mark is registered for, on the one hand, "electric and luminous portable and stationary traffic warning signs" and, on the other hand, the "installation," "custom manufacture" and "custom design for others" of "electric and luminous signs, ... and portable and stationary traffic warning signs."⁸ It is settled, we further note, that while use-based

⁶ Such registrations are: Reg. No. 2,303,318, issued on December 28, 1999; Reg. No. 1,458,000, issued on September 22, 1987; and Reg. No. 1,192,923, issued on April 6, 1982.

⁷ Those registrations are: Reg. No. 2,303,318, issued on December 28, 1999; and Reg. No. 1,458,000, issued on September 22, 1987.

⁸ The registrations are: Reg. No. 2,098,978, issued on September 23, 1997; and Reg. No. 2,098,945, issued on September 23, 1997.

third-party registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, such registrations may nevertheless have some probative value to the extent that they serve to suggest that the goods and/or services listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

Applicant, while seeming to indicate in its main brief that its "TRAFFICMASTER" mark is currently in actual use even though a statement of use has not been filed in connection with its application, argues that "the systems with which the subject trademark is used and the signs for which the cited mark is registered are so diverse as to preclude a likelihood of confusion."⁹ Applicant also asserts that the channels of trade in

⁹ In addition, applicant contends that the Examining Attorney has mischaracterized its goods by viewing the identification thereof "in a vacuum" so as to encompass items in the nature of electric signs and displays for providing emergency information. Such an approach, applicant insists in its main brief, is improper inasmuch as it "has defined its designation of goods in specific terms of components which will be recognized in the trade as considerably afield from signs" and "has submitted patent documents which clearly illustrate the nature of its goods." Although applicant, as support for its position, cites In re Trackmobile Inc., 15 USPQ2d 1152, 1154 (TTAB 1990), a case in which this Board stated, among other things, that "when the description of goods for a cited registration is somewhat unclear, as is the case herein, it is improper to simply consider that description in a vacuum and attach all possible interpretations to it when the applicant has presented extrinsic evidence showing that the description of goods has a specific meaning to members of the trade," such case is of little help to applicant. Here, the problem is that it is the identification of applicant's goods, instead of the identification set forth in the cited registration, which is "somewhat indefinite" given the broad rather than specific manner in which applicant has designated its goods. Moreover, as pointed out in *Trackmobile* (*italics in original*):

which registrant's goods "would be sold are so significantly different from [those for] the goods and services of the instant application ... that there is no likelihood of confusion."

In particular, with respect to the "extreme diversity" in the nature of its goods and services as compared to registrant's goods, applicant maintains in its initial brief that:

Applicant's trademark is used with systems which include computer networks, communications networks and mobile terminals for collecting, compiling, and transmitting data throughout the networks. Such systems cost over \$1,000,000 and are extremely complex. Examples of such systems are described in the previously submitted ... [copies of] U.S. Patent No. 5,317,311 and International Patent Application Publication No. WO98/36398 Applicant's goods and services involve the monitoring of road traffic and distribution of road traffic information so obtained, particularly for subscribers to the information service, such as operators of fleets of vehicles and similar businesses.

The goods of the cited registration are nothing more than signs which may be set up to indicate a specific condition. This could be in a building, in a park, or in a home. There is no indication of the area in which such signs are used, except to indicate emergencies. The examiner has assumed that such signs are used for traffic control. Further, the goods of the cited registration are described in the designation of goods as "non-trippable" ... [and] "non-electric".

It is clear that in determining the issue of likelihood of confusion in ex parte cases, this Board must compare applicant's goods as set forth in its application with the goods as set forth in the cited registration. It is improper to decide the issue of likelihood of confusion based upon a comparison of applicant's actual goods with registrant's actual goods.

Id. at 1153.

These descriptive terms illustrate the simple nature of these signs. They provide a visual warning only. They may cost at most in the hundreds of dollars as compared to the cost of the goods of the subject application.

According to applicant, "[s]uch extreme differences in goods [and services] preclude a likelihood of confusion as to source." Applicant, with respect to the Examining Attorney's contention that the same individuals would be responsible for purchasing the goods and services at issue, also urges in its main brief that, due to the complexity and expense of its "computer and communication network[s]," "such networks are generally customized to the particular application." Applicant therefore asserts that "any purchaser thereof would be knowledgeable and sophisticated and capable of understanding the complex technologies involved," with the result that "[t]his customer base would definitely perceive that such products [and services] would be from a source which is different than a producer of signs."

As to the patent documents made of record by applicant, we observe that the abstract for the international patent application refers to a "method of monitoring traffic flow," while the abstract for the U.S. Patent describes the following:

A traffic congestion monitoring system [which] comprises infrared monitoring units bolted to the sides of bridges over a motorway network and emitting information as to traffic congestion at their locations, a control center which receives and transmits the information, and paging units in respective vehicles ... [for] receiving the information and visually displaying the same upon diagrams of the network or zones thereof.

Furthermore, with respect to the third-party registrations made of record and relied upon by the Examining Attorney, applicant not only "disputes that such citations even support the Examiner's contention that electric and non-electric signs are sold by the same company," but in any event insists that "[t]he Examiner has not cited any support for the notion that one company sells signs as well as computer and communications network equipment for the purposes of controlling, monitoring, and communication of status of traffic."

Upon careful consideration of the arguments and evidence presented, we concur with applicant that, on this record, it has not been shown that contemporaneous use of the highly suggestive mark "TRAFFICMASTER" by applicant for its goods and services is likely to cause confusion with the use thereof by registrant for its goods. It is well settled, of course, that the issue of likelihood of confusion must be determined on the basis of the goods and services as set forth in the involved application and the goods as described in the cited registration. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the goods and services in the application at issue and the goods in the cited registration are broadly described as to their nature and type, it is presumed in each instance that in scope the application and registrations encompass not only all goods and/or services of the nature and

type described therein, but that the identified goods move and/or the recited services are rendered in all channels of trade which would be normal therefor and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Here, while applicant has not challenged the Examining Attorney's treatment of registrant's goods as including portable, non-tippable, non-electric warning signs, a strict reading of the identification of registrant's goods would seem to indicate, however, that registrant's goods do not encompass signs of any kind. Instead, the identification of registrant's goods appears to cover both "portable non-tippable display apparatus" which is "for use in displaying warning messages in emergency-type situations," with such messages being "in the nature of non-electric signs," and "metal sign stands." Such portable non-tippable display apparatus and metal sign stands are obviously even more dissimilar, and hence even less possibly related, to applicant's goods and the services it renders in association therewith than would be electric signs and displays for providing emergency information.

Nonetheless, to address the arguments presented, even if registrant's goods are construed as including "portable non-tippable display apparatus" which is "in the nature of non-electric signs" which are "for use in displaying warning messages in emergency-type situations," such goods have not been shown to be closely related, in a commercial sense, to applicant's goods. Specifically, when registrant's identification of its goods is so

read and applicant's broad identification of its goods is construed as encompassing items in the nature of electric signs and displays for providing emergency information, the record contains only three instances in which third parties have registered a mark for such goods as well as for the kinds of portable, non-tippable, non-electric signs for use in displaying warning messages in emergency-type situations offered by registrant. Similarly, with respect to applicant's goods, as construed to include items in the nature of electric signs and displays for providing emergency information, and registrant's metal sign stands, the record demonstrates only two instances in which third parties have registered a mark for both types of products.

We find, in light thereof, that not only is the evidence insufficient to establish that the relevant purchasing public would regard such goods as closely related in a commercial sense, in that they would expect goods of those types to emanate from the same source and to be available through the same channels of trade, but there is even less evidence to demonstrate that the technologically complex and highly expensive electronic apparatus and instruments offered by applicant for monitoring and providing of road traffic information, including information as to road traffic congestion and speed of individual road vehicles, comes from or is affiliated with the same source which provides (regardless of how registrant's identification of goods is interpreted) the relatively inexpensive--and decidedly commonplace--metal sign stands and portable, non-tippable display

apparatus and non-electric signs for use in displaying warning messages in emergency-type situations marketed by registrant. Furthermore, there is absolutely no evidence which even suggests that the relevant purchasing public has become accustomed to or otherwise would readily assume that the kinds of detailed, current, road traffic information, monitoring and consultation services provided by applicant have their origin with or are sponsored by the same entity which produces the types of ordinary, metal sign stands and non-tippable, non-electric, portable warning signs and display apparatus sold by registrant.

Moreover, while it appears to be the case that the particular individuals responsible for purchasing applicant's goods and subscribing to its associated services would typically be employed by fleet vehicle operators (including, admittedly, various departments of municipalities, such as school districts, sanitation services, or state highway departments), there is simply no showing that these purchasers would also be the same group of buyers who would select and purchase registrant's goods. As noted, for example, by our principal reviewing court in *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), it is error to deny registration simply because applicant markets and sells its goods and/or services in one (or more) of the same fields (e.g., emergency traffic information) as those utilized by registrant for its goods without also determining who are the relevant purchasers in instances of common institutional customers. That is, the mere purchase of both applicant's goods

and services and registrant's goods by the same institutions does not, of itself, establish similarity of trade channels or overlap of customers. Any likelihood of confusion must, instead, be shown to exist not in a purchasing institution but in a shared customer or purchaser. Thus, our principal reviewing court has cautioned in this regard that:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.

Id., quoting from *Witco Chemical Co. v. Whitfield Chemical Co.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g*, 153 USPQ 412 (TTAB 1967).

Finally, even if there are situations in which the customers for applicant's goods and services are the same individual buyers as those who purchase registrant's goods, such purchasers nonetheless would undoubtedly be knowledgeable and sophisticated customers who would select applicant's goods and services only after careful consideration and reflection, especially given the high cost thereof. While, as the Examining Attorney points out, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are discriminating when it comes to trademarks and/or service marks or immune from source confusion,¹⁰ the degree of deliberation and technical sophistication which clearly would be

¹⁰ See, e.g., *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962); *In re Decombe*, supra at 1814-15; and *In re Pellerin Milnor Corp.*, supra at 560.

required by customers for applicant's goods and services, as opposed to registrant's far more everyday goods, would thereby significantly decrease any likelihood of confusion.

Accordingly, and inasmuch as the mark "TRAFFICMASTER" is highly suggestive of the respective goods and services and thus merits but a narrow ambit of protection, we find on this record that the contemporaneous use by applicant of such mark for goods and services which are so significantly different in their technological nature and cost from the goods in connection with which registrant uses the same mark is not likely to cause confusion.

Decision: The refusal under Section 2(d) is reversed.